

Appln No. 09/975,532

Amdt date April 13, 2005

Reply to Office action of December 14, 2004

#### REMARKS/ARGUMENTS

Applicants thank the Examiner for his careful consideration of this application. Applicants submit herewith a supplemental Information Disclosure Statement and ask the Examiner to consider the references. In response to the above-identified Office action, Applicants amend parts of the application and seek reconsideration, reexamination and allowance thereof. In this Response, Applicants do not cancel any claims. Applicants amend claims 1, 11, 13, 25, 32, 38, 40, and 41. Applicants add claims 42-44. Accordingly, claims 1 through 44 are pending.

#### Claims Rejected Under 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 4,780,828 issued to Whisker (hereinafter "Whisker") in view of U.S. Patent No. 6,311,214 issued to Rhoads (hereinafter "Rhoads") and either U.S. Patent No. 6,108,643 issued to Sansone (hereinafter "Sansone") or U.S. Patent No. 6,701,304 issued to Leon (hereinafter "Leon"). Applicants respectfully request that the rejection be withdrawn.

In order to establish a *prima facie* case of obviousness, the Examiner must show the cited references, combined, teach or suggest each of the elements of a claim. Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP § 2143.01.

In regard to independent claim 1, this claim, as amended, includes the elements "receiving a label stock comprising a set of labels each having a pre-printed serial number, each pre-

Appln No. 09/975,532

Amdt date April 13, 2005

Reply to Office action of December 14, 2004

printed serial number related to a single master serial number that identifies the label stock" and "generating an indicium in accordance with the master serial number, pre-printed serial number, and the postage request, the indicium including an indicator verifying a match with the pre-printed serial number." Applicants do not believe that Whisker, Rhoads, Sansone or Leon teach or suggest these elements of claim 1. Applicants have been unable to discern any part of the cited references that teaches or suggests these elements of claim 1. Specifically, Whisker does not teach the use of a label stock, as acknowledged by the Examiner on page 2 of the Office action mailed December 14, 2004. Further, the Applicants have reviewed Rhoads, Sansone and Leon, but have been unable to discern any part therein that teaches a label stock having a master serial number related to a serial number printed on a label of the stock. Thus, Whisker in view of Rhoads, Sansone or Leon does not teach or suggest each of the elements of independent claim 1.

Further, Whisker has not been properly combined with Rhoads, Sansone or Leon. The Examiner acknowledges that Whisker does not teach the use of a label stock and justifies the combination of Whisker with Rhoads, Sansone and Leone, by arguing "[i]t would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Whisker because the preprinted labels are conventional functional equivalents with respect to the claim limitations in preprinted mail pieces." However, Whisker explicitly teaches away from the use of individual postage or postage labels for each mail piece. Rather, Whisker teaches "a system for accounting for postage on large batches of mail without franking of each mail piece." See Abstract, Whisker. Thus, one of

Appln No. 09/975,532

Amdt date April 13, 2005

Reply to Office action of December 14, 2004

ordinary skill in the art would not think to combine individual postage labels for individual mail pieces with the system taught by Whisker. Therefore, Whisker cannot be properly combined with Rhoads, Sansone or Leon to teach each of the elements of claim 1. Therefore, claim 1 as amended is not obvious over Whisker in view of Rhoads, Sansone or Leon. Accordingly, reconsideration and withdrawal of the obviousness reject of this claim are requested.

In regard to claims 2-12, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 1, these claims are not obvious over Whisker in view of Rhoads, Sansone or Leon. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

Independent claims 13, 25, 32, 38, 40 and 41 have been amended to include the elements of "generating an indicium in accordance with the master serial number, pre-printed serial number, and the postage request, the indicium providing a visual verification of a match with the pre-printed serial number" (claim 13), "receiving a label stock with at least one pre-printed serial number on a label, the pre-printed serial number related to a master serial number of the label stock", "generating an indicium in accordance with the master serial number, pre-printed serial number, and the postage request, the indicium providing means for verifying the validity of the postage" (claim 25), "printing the postage using the indicium and the first label, the indicium providing means for verifying the validity of the postage," "rejecting a subsequent postage request for a second label with the pre-printed serial number"

**Appln No. 09/975,532**

**Amdt date April 13, 2005**

**Reply to Office action of December 14, 2004**

(claim 32), "generating an indicium in accordance with the pre-printed serial number and the postage request, the indicium providing means for verifying the validity of the postage by a known correspondence to the pre-printed serial number" (claim 38), "blocking subsequent use of the pre-printed serial number" (claim 40) and "generating a label stock display using the label stock type and label starting sequence, the label stock display providing means for verifying the validity of the postage in relation to the label starting sequence number" (claim 41). Applicants believe that the cited references fail to teach or suggest each of these elements of the amended independent claims. Further, as discussed above in regard to independent claim 1, Whisker cannot be properly combined with Rhoads, Sansone or Leon to teach or suggest each of the elements of the independent claims. Whisker explicitly teaches away from the use of individual labels for mail pieces. The Examiner offers the same rationale for combining Whisker with Rhoads, Sansone or Leon for independent claims 13, 25, 32, 38, 40 and 41 as offered in regard to claim 1. Thus, Whisker cannot be properly combined with Rhoads, Sansone or Leon to teach or suggest each of the elements of these independent claims. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to claims 14-24, 26-31, 33-37 and 39, these claims depend from the independent claims 13, 25, 32 and 38 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to the independent claims, these claims are not obvious over Whisker in view of Rhoads, Sansone or Leon. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

Appln No. 09/975,532

Amdt date April 13, 2005

Reply to Office action of December 14, 2004

### New Claims

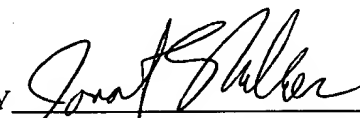
New claims 42-44 depend from independent claim 1, either directly or indirectly, and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 1, Applicants believe these claims are allowable over the cited references.

### Conclusion

In view of the foregoing, it is believed that all claims now pending, namely claims 1-44, patentably define the subject invention over the prior art of record and are in condition for allowance, and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (626) 795-9900.

Respectfully submitted,  
CHRISTIE, PARKER & HALE, LLP

By



Jonathan S. Miller

Reg. No. 48,534

626/795-9900

SAH/amb

CAH PAS612266.1-\* -04/13/05 12:54 PM